

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS D. SCIUGA, SALVATORE J. SCIUGA
and KEITH J. TUPPER

Appeal No. 97-4253
Application No. 08/385,981¹

ON BRIEF

Before Abrams, Frankfort and CRAWFORD, Administrative Patent
Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 1 through 6, 9 and 10, which are all of
the claims pending in this application. Claims 7, 8 and 11
through 13 are allowed.

¹ Application for patent filed February 9, 1995.

Appeal No. 97-4253

Application No. 08/385,981

The appellants' invention relates to an insert for use in a corner piece of a synthetic siding of the type that is applied to the exterior of a building. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

O'Hanlon	3,854,260	Dec. 17, 1974
Nishioka et al. (Nishioka)	4,542,164	Sep. 17, 1985
Fragale	5,090,174	Feb. 25, 1992

The rejections

Claims 1 through 4, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fragale in view of O'Hanlon.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fragale in view of O'Hanlon as applied to claims 1 through 4, 9 and 10 above, and further in view of Nishioka.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed March 13, 1997) and the supplemental examiner's answer (Paper No. 16, mailed June 13, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 11, filed January 24, 1997), reply brief (Paper No. 13, filed April 21, 1997) and supplemental reply brief (Paper No. 15, filed June 2, 1997) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1 through 4, 9 and 10 under 35 U.S.C. § 103 as unpatentable over

Fragale in view of O'Hanlon. It is the examiner's finding that Fragale discloses the claimed insulative insert for use in a corner member of siding which is L-shaped and fits snugly into the flanges of the associated corner member. The examiner states that Fragale does not disclose a one-piece insert which is resilient and compressible. The examiner finds that O'Hanlon discloses a similar corner construction comprised of a one-piece insert and associated corner members and that the O'Hanlon insert may be any suitable type of polyurethane which may be rigid or flexible. The examiner concludes:

The use of a one-piece insert (as taught by O'Hanlon) for Fragale would have been obvious to one of ordinary skill in the art, so that fewer components would be needed at the construction site, and assembly of the corner/insert would be made easier-- i.e. workers would only have to install one member into the corner as opposed to two or more section[s] of the foam material, which would make installation easier since one component would be received and held in the corner without the need for manually holding several foam insert sections within the corner. The use of compressible/flexible foam materials (as taught by O'Hanlon) for Fragale's foam insert would have been obvious to one of ordinary skill in the art, since this material was well known in

the art at the time of the invention as a suitable insulative "plug" or lining material, and one of ordinary skill in the art would have obviously considered any readily available foam materials to meet the criteria of Fragale's assembly.[examiner's answer at page 5].

The appellants argue that neither Fragale nor O'Hanlon suggest using a compressible and resilient one-piece foam insert for the corner piece of synthetic siding for a building but rather use rigid foam that is adhered to sheet aluminum utilized for structural support. In addition, appellants argue that both Fragale and O'Hanlon employ a single length of foam that extends

along the entire length of the associated trim piece or aluminum skin.

The examiner argues that since the claims are directed to a foam insert only, any arguments concerning the strength provided to the corner members of either Fragale or O'Hanlon, as well as the claimed lengths of these inserts with respect to associated corner members are moot.

While the examiner is correct that the claims are directed to an insert only and not a combination of an insert

and a corner member, the insert which is claimed is a "one-piece resilient compressible L-shaped foam member". In addition, the insert is "of a thickness significantly less than the length of the corner piece" as recited in claim 1 or has "a thickness on the order of one inch" as recited in claim 10.

In regard to the requirement that the foam be resilient and compressible, appellants argue that since Fragale discloses that the foam layer provides additional structural rigidity to the panel and since O'Hanlon discloses that the foam-type substance becomes suitably hardened so as to hold various parts of the joint in rigid alignment, these references disclose rigid foam. We do not agree. In our view, the foam disclosed in Fragale and O'Hanlon is resilient and compressible at least to some degree and such resiliency and compressibility would not prevent the foam from (1) providing at least some structural rigidity in Fragale or (2) holding the various parts in rigid alignment in O'Hanlon.

In regard to the recitations in claims 1 and 10 concerning the thickness of the insert, the examiner states that:

Making Fragale/O'Hanlon's insert one inch thick would also have been an obvious design consideration for one of ordinary skill in the art, based upon the amount of reinforcement desired for the corner member--the longer the insert, the more reinforcement provided to the corner member and the more "filler" to prevent insects, weather, etc. from entering the corner's interior. [examiner's answer at page 6]

We do not agree with the examiner. Fragale discloses that the foam insert is utilized to provide additional structural rigidity to the panel. A foam insert that was either significantly less than the length of the corner piece as recited in claim 1 or a thickness that was on the order of one inch as recited in claim 10 would not provide this support. O'Hanlon discloses that the insert provides additional structural rigidity to the panel. A foam insert that was either significantly less than the length of the corner piece or on the order of one inch would not provide this structural rigidity to the panel. As such, we conclude that the provision of the recited thicknesses would not have

been a matter of the design choice. As such we will not sustain this rejection.

We have reviewed the disclosure of Nishioka and have determined that this reference does not cure the deficiencies noted above for the combination of Fragale and O'Hanlon. Therefore, we will not sustain the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103 as unpatentable over Fragale and O'Hanlon in further view of Nishioka.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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CRAWFORD

APPEAL NO. 97-4253 - JUDGE

APPLICATION NO. 08/385,981

APJ CRAWFORD

APJ Frankfort

APJ Abrams

DECISION: **Affirmed**

Prepared By: Gloria Henderson

DRAFT TYPED: 06 Dec 99

FINAL TYPED: